

**R E M A R K S**

Claims 12-25, 27-30, 34, 35 and 37-40 are pending and stand ready for further action on the merits. Claims 1-11, 26, 31-33 and 36 have been canceled.

Support for the amendment to claim 12 can be found on page 13, lines 18-19.

The dependency of claim 13-15 and 18-21 has been changed so that these claims are not dependent upon cancelled claim 11.

No new matter has been added by way of the above amendments.

**Rejections under 35 U.S.C. § 102(b)**

The Examiner has maintained the rejection of claims 3, 4, 8-10, 22, 24, 26, 31, 32, and 36 under 35 U.S.C. § 102 (b) as being anticipated by any one of Nudenberg et al. (U.S. Pat. No. 3,424,736), GB '467, WO '567, GB '031, GB '434, FR '571, and EP '120. Applicants respectfully traverse each of the rejections.

With respect to claims 3, 4, 8-10, 26, 31, 32 and 36, the rejection is rendered moot in view of the cancellation of these claims.

The following comments relate to pending claims 22 and 24.

In the outstanding Office Action, the Examiner includes claims 22 and 24 in the rejection. The Examiner has taken the position that the instant claims are directed to a process of making a titanium catalyst comprising reacting a titanium compound with a Grignard reagent and that the step of combining the

titanium/Grignard catalyst with the substrate is not given patentable weight, since the recitation of this step is located in the preamble.

The Examiner's attention is directed to the process step in claim 22 of "deallylating... an allyl-substituted malonate ester derivative represented by the formula (3)..." . Claim 22 has been amended to emphasize this deallylating step by including the different steps as separate paragraphs without changing the scope of the claim. It is clear from claim 22 that this deallylating step is step in the process of claim 22 and is not merely an intended use.

In describing the requirements for rejection of a claim by anticipation, the Manual of Patent Examining Procedure (Section 2131) states:

[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference (ref. omitted). The identical invention must be shown in as complete detail as is contained in the... claim (ref. omitted).

Accordingly, every element in a claim must be found in the reference in order that the reference anticipates the claim. Upon review of each of the cited references (Nudenberg et al. (U.S. Pat. No. 3,424,736), GB '467, WO '567, GB '031, GB '434, FR '571, and EP '120), it is clear that none of these references teach or fairly suggest a process which includes a step of deallylating an allyl-

substituted malonate ester derivative of formula (3) using the inventive Ti/Grignard catalyst as presently claimed. Therefore, the references do not anticipate the claims, and as such, Applicants respectfully request that the rejection be withdrawn.

**GB-A-948 714 (GB '714)**

The Examiner will note in the Information Disclosure Statement, which is co-filed herewith, Applicants submit GB '714 for the Examiner's consideration.

It is Applicants' position that the subject matter of GB '714 is most closely related to inventive claim 12. Accordingly, in order to further distinguish from GB '714, Applicants have amended claim 12 to recite that the reagent is formed at a temperature in the range of -78 - 0°C. In GB '714, the titanium compound, a Grignard reagent and a compound having a carbon-carbon unsaturated bond are combined in diethyl ether under **refluxing conditions**. Accordingly, significant patentable distinctions exist between GB '714 and the present invention.

**Allowable Claims**

Applicants note with appreciation that the Examiner has allowed independent Claims 11 (with dependent Claims 13-15, 18-21, and 33), 12 (with dependent claims 13, 21, and 34), 23, 25 (with dependent Claim 35), 27 (with dependent claim 37), 28 (with dependent Claim 38), 29 (with dependent Claim 39), and 30 (with

dependent Claim 40). The Examiner has also allowed dependent Claims 16 and 17, which rely on other dependent claims.

CONCLUSION

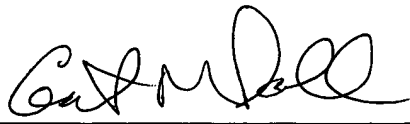
In view of the above amendments and comments, Applicants respectfully submit that the claims are in condition for allowance. A Notice to such effect is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact **Garth M. Dahlen, Ph.D., Esq.** (Reg. No. 43,575) at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachment(s): Information Disclosure Statement